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09/688,392	10/16/2000	Thomas C. Naratil	4034-20	2870

7590

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EXAMINER

HAMILTON, LALITA M

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/688,392

Applicant(s)

NARATIL, THOMAS C.

Examiner

Lalita M Hamilton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

Claims 9 and 13 are objected to because of the following informalities:

"dealer=s" should be "dealers". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected for the following reasons:

In claim 1, "dealer response" lacks antecedent basis.

In claim 4, "best response" lacks antecedent basis.

Claims 2-3 and 5-11 are rejected for their dependency upon rejected claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, 10-12, 14-15, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Giovannoli (5,842,178).

Giovannoli discloses a computer quotation system and product comprising an updatable offering inventory module for tracking, receiving and displaying securities

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offerings and information (col.4, lines 8-29—has capability of performing RFQ functions with securities or any other product in which the user desires); a price discovery module for forwarding requests for quotations (RFQ's) to at least one dealer and capturing and transmitting the dealer responses for display in the offering inventory module, and executing a trade based on a best RFQ response (col.5, line 52 to col.6, line 15 and fig.8-all); an internal module which affords internal users access to the offering inventory module and price discovery module (col.4, lines 1-29); the securities offerings and information in the offering inventory module is automatically updated (col.4, lines 1-29); the dealers receiving the RFQ are pre-determined by a sender (col.5, lines 12-39); selected users can view all of the responses in the offering inventory module (col.5, lines 12-52); non-selected users can only view a best response in the offering inventory module (col.5, lines 12-52); a pricing proof system for determining the best response for a security (col.5, lines 12-57); the securities offering and information in the offering inventory module is manually updated (col.4, lines 4-53); a computerized workstation for communicating trade information, an updatable offering inventory module for tracking, receiving and displaying securities offerings and information, a price discovery module for sending a request for quotes (RFQ's) to pre-determined dealers and receiving responses thereto, wherein responses received are transmitted for display in the offering inventory module, and an internal module for internal users to access the offering inventory module and price discovery module, wherein the system executes a trade pursuant to a best RFQ (col.4, lines 4-53 and col.5, line 12 to col.6, line 14); the securities offerings and securities information in the offering inventory database is

automatically updated (col.4, lines 1-29); the securities offerings and information in the offering inventory database is manually updated (col.4, lines 1-53); a program product having an offering inventory means for tracking, receiving and displaying securities offerings and information, price discovery means for sending a request for quotes (RFQ's) to dealers, wherein dealer responses to the RFQ's are received by the price discovery means and transmitted for display in the offering inventory means, and operations means for providing users access to the offering inventory means and the price discovery means (col.4, lines 4-53 and col.5, line 12 to col.6, line 14).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 8-9, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli in view of Waelbroeck (US 2002/0052827).

Giovannoli discloses the invention substantially as claimed; however, Giovannoli does not disclose a system that allows a sender of a RFQ to improve the best response and execute a trade as a principal; price discovery module includes a time management system; the time management system comprising means for setting a first time limit that determines an amount of time for dealers to respond to the requests, means for setting a second time limit that determines an amount of time for a sender of a request to decide whether to accept a dealers response, and means for

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setting a third time limit that determines an amount of time, after the second time limit has passed, for the sender to inquire whether the response is still valid, or a method for trading taxable and non-taxable securities. Waelbroeck teaches a system and method for directing and executing certified trading interests comprising a system that allows a sender of a RFQ to improve the best response and execute a trade as a principal (p.14, 118 and p.21, 186); price discovery module includes a time management system; the time management system comprising means for setting a first time limit that determines an amount of time for dealers to respond to the requests, means for setting a second time limit that determines an amount of time for a sender of a request to decide whether to accept a dealers response, and means for setting a third time limit that determines an amount of time, after the second time limit has passed, for the sender to inquire whether the response is still valid (p.4, 33), and a method for trading taxable and non-taxable securities (p.2, 11-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a system that allows a sender of a RFQ to improve the best response and execute a trade as a principal; price discovery module includes a time management system; the time management system comprising means for setting a first time limit that determines an amount of time for dealers to respond to the requests, means for setting a second time limit that determines an amount of time for a sender of a request to decide whether to accept a dealers response, and means for setting a third time limit that determines an amount of time, after the second time limit has passed, for the sender to inquire whether the response is still valid, and a method for trading taxable and non-taxable securities, as taught by

Waelbroeck into the invention disclosed by Gionvannoli, to demonstrate that the RFQ of Giovannoli may be used in conjunction with securities or any product and to ensure that a sufficient amount of time is given for conducting the transaction until completion.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
LMH